UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,111	08/09/2001	Stephen Pegram	VTN-0547	2744

27777 7590 01/29/2004

PHILIP S. JOHNSON
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 08933-7003

EXAMINER
TADESSE, YEWEBDAR T

ART UNIT	PAPER NUMBER
1734	

DATE MAILED: 01/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/925,111	PEGRAM ET AL.	
	Examiner	Art Unit	
	Yewebdar T Tadesse	1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *06102003* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: In the applicant's specification, pages 5 and 7, applicant left blank spaces for the US Patent serial numbers to be filled. Applicant is required to fill the information in the spaces. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 7-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, applicant discloses movement-preventing means for the first mold part. However in claims 7-8, the speed of the movement of the first mold is claimed. It is unclear whether the first mold is held stationary or in movement in relation to the second mold part. In applicant's specification, page 15, lines 4-7, the travel rate of the back curve (second mold part) being less than 0.35 mm/sec and 0.1-0.3 mm/sec. For the purpose of examination, the apparatus moving the second mold part at the claimed speed is assumed.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 3-5, 11,13 and 15-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Hwang (US 4,786,444). Hwang discloses (see columns 2-3, lines 64-68, and 1-8 respectively and Figs 2-4) an apparatus for assembling first and second mold parts having contact lens (making molded optical devices including contact lens with first and second mold portions 12 and 13) wherein the first mold part (female mold half 13) having a reaction mixture (reactive material 58) on the contact lens forming surface and a second mold (male mold half 12) moved vertically with the top support controlled by the height adjustment means 34. Hwang teaches (see column 3, lines 13-35) movement preventing means (positioning means 15 attached to a vacuum pump for the second mold or male mold half 12, and locating means 17 for the first mold or female mold half 13) to hold the mold portion in the desired position of the supports. Hwang device height adjustment means is capable of controlling the positioning of the second mold part relative to the first mold part carrying reaction mixture on it.

As to claims 3-5, Hwang discloses (see column 3, lines 36-46 and Fig 4) movement preventing means of movable mechanical means type (inner sleeve 55 slidable in outer sleeve 54). The inner sleeve 55 can be considered as a finger preventing movement of the mold part.

As to claim 11, Hwang discloses (see column 1, lines 9-21, columns 2-3, lines 64-68, and 1-8 respectively and Figs 2-4) a method for assembling first and second mold parts having contact lens (making molded optical devices including contact lens with first and second mold portions 12 and 13) wherein the first mold part (female mold half 13) having a reaction mixture (reactive material 58) on the contact lens forming surface and a second mold (male mold half 12) moved vertically with the top support controlled by the height adjustment means 34. Hwang teaches (see column 3, lines 13-35) the step of movement preventing means (positioning means 15 attached to a vacuum pump for the second mold or male mold half 12, and locating means 17 for the first mold or female mold half 13) to hold the mold portion in the desired position of the supports. In Hwang the positioning of the second mold part relative to the first mold part carrying reaction mixture is controlled by the height adjustment means. As to claims 13-15, Hwang discloses (see column 3, lines 36-46 and Fig 4) movable mechanical means type (inner sleeve 55 slidable in outer sleeve 54) holding the mold part to prevent movement. The inner sleeve 55 can be considered as a finger preventing movement of the mold part.

As to claim 13 and 15-16, Hwang discloses (see column 3, lines 36-46 and Fig 4) movement preventing means of movable mechanical means type (inner sleeve 55 slidable in outer sleeve 54). The inner sleeve 55 can be considered as a finger preventing movement of the mold part.

6. Claim 1 and 7-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Martin et al (US 5,658,602). Martin et al discloses (see Fig 1a-1e, Abstract, column 16-17, lines 55-67 and 1-2 respectively) an apparatus for assembling first and second mold parts having contact lens (back mold halves are coupled to the front curve halves in forming contact lens) wherein the first mold part (front mold half 31) is filled with a reaction mixture (polymerizable hydrogel 10). In Martin et al device, piston shafts 71 with manifold housings 72, 73 and cylinders 93 controllably moving a second mold part (by pressurizing the piston at predetermined value), movement preventing means (pallet 30b, see Fig 1d) preventing the front curve halve from moving and the pneumatic cylinders 93 capable of controlling the positioning of the second mold part relative to the first mold part carrying reaction mixture on it. As to claims 7-8, Martin et al also discloses (see column 16, lines 38-41) an apparatus moving the second mold at speed of 0.2-1 mm/sec (0.35 mm/sec falls within the range and some overlapping speed of the range 0.1-0.3 mm/sec al).

7. Claims 9-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Martin et al (US 5,658,602). Martin et al discloses (see Fig 1a-1e, Abstract, column 16-17, lines 55-67 and 1-2 respectively) an apparatus for assembling first and second mold parts having contact lens (back mold halves are coupled to the front curve halves in forming contact lens) wherein the first mold part (front mold half 31) is filled with a reaction mixture (polymerizable hydrogel 10), the apparatus comprising a nozzle (piston shafts 71 with manifold housings 72, 73 and cylinders 93) controllably moving a second

mold part (by pressurizing the piston at predetermined value). Martin et al also discloses (see column 16, lines 38-41) assembling speed of 0.2-1 mm/sec (0.35 and 1 mm/sec included in the range) of the apparatus. Martin et al device's pneumatic cylinders 93 are capable of controlling the positioning of the second mold part relative to the first mold part with reaction mixture on it.

8. Claims 11, and 18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Martin et al (US 5,658,602). Martin et al discloses (see Fig 1a-1e, Abstract, column 16-17, lines 55-67 and 1-2 respectively) a method for assembling first and second mold parts having contact lens (back mold halves are coupled to the front curve halves in forming contact lens) wherein the first mold part (front mold half 31) is filled with a reaction mixture (polymerizable hydrogel 10). In Martin et al's method of assembly of contact lens, movement preventing means (pallet 30b) prevents the first mold (curve halve) from moving, piston shafts 71 with manifold housings (72, 73) and cylinders 93 controllably moving a second mold part (by pressurizing the piston at predetermined value), and positioning of the second mold part relative to the first mold part with reaction mixture on it is controlled by the pneumatic cylinders 93. As to claims 18-19, Martin et al also discloses a method assembling or controllably moving the second mold at speed of 0.2-1 mm/sec (0.35 mm/sec falls within the range) of the apparatus (see column 16, lines 38-41).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hwang (US 4,786,444) as applied to claim 1 above and further in view of DeRozier et al (US 5,620,635). Hwang teaches (see column 3, lines 13-35) movement preventing means (positioning means 15 attached to a vacuum pump for the second mold or male mold half 12, and locating means 17 for the first mold or female mold half 13) to hold the mold portion in the desired position of the supports. However, movement preventing means comprising a vacuum for the first mold half (female mold half 13) is not taught in Hwang. It is well known in the art to use vacuum force either in the first or second half portion to align the portions in the interface surface of the support; for instance - DeRozier et al discloses (see Fig 1 and claim 10) at least one of the lens mold assemblies provided with a vacuum channels (48, 64) extending through the lens die support from the lens

die interface surface. It would have been obvious at the time the invention was made to include a movement preventing means which prevent the first mold part from moving in Hwang to secure the mold half (lens die) to the support by vacuum pressure as taught by DeRozier.

12. Claims 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hwang (US 4,786,444) as applied to claim 11 above and further in view of DeRozier et al (US 5,620,635). Hwang teaches (see column 3, lines 13-35) the step of movement preventing means (positioning means 15 attached to a vacuum pump for the second mold or male mold half 12, and locating means 17 for the first mold or female mold half 13) to hold the mold portion in the desired position of the supports. However, the step of movement preventing using a vacuum (source) for the first mold half (female mold half 13) is not taught in Hwang. It is well known in the art to apply vacuum force in preventing movement either in the first or second half portion to align the portions in the interface surface of the support; for instance - DeRozier et al discloses (see Fig 1 and claim 10) at least one of the lens mold assemblies provided with a vacuum source channels (48, 64) extending through the lens die support from the lens die interface surface. It would have been obvious at the time the invention was made to include the step of movement preventing means which prevent the first mold part from moving in Hwang to secure the mold half (lens die) to the support by vacuum pressure as taught by DeRozier.

13. Claims 6 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hwang (US 4,786,444) as applied to claims 1 and 11 above and further in view of Morland et al (US 5,114,629). Hwang lacks teaching a movement preventing means comprising weight for the first mold part. Morland et al discloses a process and apparatus for casting lens using male and female mold halves wherein the male mold halve fall under its own load or weight into the female mold half pressed together (preventing movement). It would have been obvious at the time the invention was made to include movement-preventing means comprising weight or the step of movement preventing by applying weight to the first mold (female mold half) in Hwang to maintain closing pressure until the composition has polymerized as taught by Morland et al.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yewebdar T Tadesse whose telephone number is (571) 272-1238. The examiner can normally be reached on Monday-Friday 8:00 AM-4: 30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Yewebdar T T

YTT

MICHAEL COLAIANNI
PRIMARY EXAMINER